

Remarks

The status of the claims is as follows. Claims 1-74 were originally filed and are subject to restriction. The amendment above corrects a typographical error that resulted in two claims being numbered 56. Accordingly, second Claim 56 to Claim 73 were renumbered as Claims 57-74, respectively, and were also amended to correct dependency numbering. Applicant regrets the error. It is noted that the Examiner has grouped the claims in the Restriction Requirement according to the renumbering herein. In a telephone conversation with the undersigned on November 12, 2003, the Examiner confirmed the above and was advised of Applicant's intent to submit this Preliminary Amendment along with a response to the restriction requirement.

Restriction Requirement

The Examiner required restriction under 35 U.S.C. §121 as follows:

Group I – Claims 1-32 and 49-62, drawn to an optical device, system and switch.

Group II – Claims 33-48, drawn to a method of making a liquid composition.

Group III – Claims 63-68, drawn to a method of matching a refractive index.

Group IV – Claims 69-74, drawn to a method of transmitting an optical signal.

Applicant respectfully traverses the Restriction Requirement. As mentioned in the specification, certain embodiments of the present invention include devices comprising a solid component and a liquid composition interfaced therewith. The present invention provides liquids for use in devices where the liquid is interfaced with a solid component of the device. The invention of Claims 1-32 and 49-62 includes the refractive index-matching compositions together with a device.

Claim 63 is drawn to a method for matching the refractive index of a solid component of a device where the method comprises contacting a solid component of the device with a liquid composition as claimed. Applicant submits that the invention of Claim 63 and claims dependent thereon falls within the same inventive scope as the invention of the claims of Group I.

Applicant, therefore, proposes the following grouping of claims:

Modified Group I – Claims 1-32, 49-62 and 63-68.

Modified Group II – Claims 33-48, drawn to a method of making a liquid composition.

Modified Group III –Claims 69-74, drawn to a method of transmitting an optical signal.

As required by the Restriction Requirement, Applicant elects the invention of the Examiner's Group I, Claims 1-32 and 49-62.

In making the Restriction Requirement the Examiner determined that the inventions of Groups I-IV are distinct each from the other. According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, the Examiner is acknowledging at least implicitly that the inventions of the various groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be proper.

#### Election of Species

The Examiner further required that, if Group I was elected, then Applicant must elect from three patentably distinct species as follows:

A: A device with a groove in a substrate, Claims 1-6.

B: An optical system with a groove in a substrate and control means, Claims 7-32.

C: An optical switch with a groove in a substrate and waveguides on a substrate, Claims 49-62.

Applicant respectfully traverses the election of species requirement. As mentioned in the specification and above, certain embodiments of the present invention include devices comprising a solid component and a liquid composition interfaced therewith. The present invention has at its core the provision of refractive index-matching liquids for use in devices where the liquid is interfaced with a solid component of the device. The invention of Claims 1-32 and 49-62 includes the refractive index-matching compositions together with a device. Accordingly, there are no distinct species created by the particular characteristics of the devices with respect to the invention of the claims in question.


In response to the requirement in the Election of Species, Applicant elects Species A, namely, a device comprising a solid component and a liquid composition interfaced therewith. The election of the above species should not be interpreted as acquiescence in the requirement for Election of Species, which is traversed as discussed above.

In response to the Examiner's requirement for a listing of all claims readable on the above-elected species, Applicant lists Claims 1-32 and 49-62.

SUMMARY

The claims were amended to correct a typographical error. Applicant has traversed the Restriction Requirement and proposed new groups and has also traversed the requirement for Election of Species. In response to the requirement in the Office Action, Applicant has elected the subject matter of Group I. Furthermore, as required, Applicant has elected Species A in response to the requirement for an election of species for Group I and has also listed the claims readable on the elected species.

Respectfully submitted,

  
Theodore J. Leitereg  
Attorney for Applicant  
Reg. No. 28,319

Agilent Technologies, Inc.  
Legal Department, M/S DL429  
Intellectual Property Administration  
P.O. Box 7599  
Loveland, CO 80537-0599